

Applicant : John L. Andersen
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REMARKS

The Examiner has restricted the application into two groups: Group I (claims 1-16) and Group II (claim 17); rejected claims 1-4 and 6-7 under 35 U.S.C. § 102(b); and rejected claims 5 and 8-16 under 35 U.S.C. § 103(a). For the reasons outlined below, Applicant respectfully requests that the Examiner reconsider the application.

I. RESTRICTION REQUIREMENT

The Examiner has restricted the application into two groups:

Group I: claims 1-16, drawn to a housing for a dryer venting, and

Group II: claims 17, drawn to a method for installing (a housing for dryer venting).

The Examiner states that the inventions of Group I and Group II are related, but argues that the inventions are distinct. The Applicant elects Group I, which is drawn to claims 1-16,¹ with traverse.

II. REJECTION UNDER § 102

The Examiner has rejected claims 1-4 and 6-7 under 35 U.S.C. § 102(b) as being anticipated by Harpenau U.S. Patent No. 6,491,102 ("the '102 patent").

Anticipation requires the presence of a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinen Fabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). In proceedings before the Patent & Trademark Office, the examiner bears the burden of establishing a prima facie case of anticipation based on the prior art. *In re Sun*, 31 U.S.P.Q.2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Applicant respectfully submits that the Examiner has not met the burden of establishing a prima facie case of anticipation with respect to the rejected claims.

Claim 1 of the present application recites a standoff extending rearwardly from the front face plate and having a portion of which is adapted to attach to a wood stud to hold the housing in place. The standoffs of the invention of claims 1-4 and 6-7 extend rearwardly from the front face plate and function to create a gap between the front face plate of the housing and the wood stud to

¹ Group I is believed to be claims 1-16, as indicated on page 2 of the Office Action, even though page 3 indicates that Group I is claims 1-13.

allow a drywall piece to fit therebetween, and to allow the back of the front face plate to abut flush against the drywall. (See page 6 of the present application.) The Harpenau '102 patent does not have such a structure. The '102 patent housing includes a mounting lip, designated as part number 25, which extends *laterally* from the housing. In fact, the patent states that "mounting lip 25 . . . can be located in a plane substantially parallel to the plane defined thereat by front periphery 18." ('102 patent, Col. 4, lines 58-61). It does not extend rearwardly from a front face plate, and, therefore, does not have an element of claim 1 of the present application. Thus, the Harpenau '102 patent does not anticipate claim 1 of the present application. Because the '102 patent does not anticipate claim 1, the Harpenau '102 patent cannot anticipate claims 2-4 and 6-7, which are all ultimately dependent on claim 1. Accordingly, the Applicant respectfully requests that the rejection of claims 1-4 and 6-7 under § 102(b) be withdrawn.

III. REJECTION UNDER § 103

The Examiner has rejected claims 5 and 8-16 under 35 U.S.C. § 103(a) as being unpatentable over the Harpenau '102 patent.

In order to establish a *prima facie* case of obviousness, three criteria must be met by the examiner. M.P.E.P. § 706.02(j). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fein*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference (or references) must teach or suggest all of the claim limitations. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

First, all of the rejected claims include a standoff extending rearwardly. Furthermore, claims 10-16 include a beveled portion adapted to sink into a wood stud when pressure is applied to the housing. As noted above, mounting lip 25 of the Harpenau '102 patent is not a standoff that extends rearwardly. There is nothing in the '102 patent that discusses any beveled portion of *any* part of the Harpenau box. The Harpenau '102 patent simply does not have these features.

Second, the Examiner has not cited any motivation or suggestion in the Harpenau '102 patent to use a beveled portion on the Harpenau box for attachment of the box to a wood stud. In

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fact, it would not make any sense to use a beveled portion with the mounting lip 25 of the Harpenau '102 patent based on its structure, let alone a motivation or suggestion to use such a structure.

Third, there is no reasonable expectation of success. For the same reasons as noted above, to use a beveled portion on some unidentified part of the Harpenau '102 patent box would not be reasonably expected to be successful. There would be no reason to use such a structure, such as the unique structure of the claims of the present application.

For the foregoing reasons, Applicant respectfully requests that the § 103 rejection of claims 5 and 8-16 be withdrawn.

CONCLUSION

Applicant submits that the present application is in condition for allowance, a notice of which is respectfully solicited.

Respectfully submitted,

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